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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,271	03/30/2001	Michael A. Faltys	AB-131U	7283
23845	7590	04/07/2004	EXAMINER	
ADVANCED BIONICS CORPORATION 12740 SAN FERNANDO ROAD SYLMAR, CA 91342			DROESCH, KRISTEN L	
			ART UNIT	PAPER NUMBER
			3762	17
DATE MAILED: 04/07/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,271

Applicant(s)

FALTYS ET AL.

Examiner

Kristen L Droesch

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/6/04 (amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6-16 and 20-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,6-16 and 20-34 is/are allowed.
- 6) ☒ Claim(s) 35 and 36 is/are rejected.
- 7) ☒ Claim(s) 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 35 is rejected under 35 U.S.C. 102(b) as being anticipated by Neubauer et al. (5,470,348). Neubauer et al. shows an implantable hermetically sealed case; an active electrode array comprising a plurality of active electrodes where each active electrode includes first (45, 46) and second (47, 48) electrode contacts, decoding circuitry (40, 60), a first switch (62) coupled to the decoding circuitry and the first electrode contact (45, 47) and a second switch (63) coupled to the decoding circuitry and the second electrode contact (46, 48), where the decoding circuitry responds to electrode control signals and causes the first and second switches to selectively activate one or both of the first or second electrode contacts; a battery (58); electronic circuitry housed within the sealed case (Fig. 8) including telemetry circuitry (53) processing circuitry (52) that generates the electrode control signals, and control circuitry (56) that applies the electrode control signals to the switching circuitry of the active electrode array, and pulse generation circuitry (50) (Figs. 7-9; Col. 5, line 9-Col. 6, line 43).

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neubauer et al. (5,470,348). Neubauer et al. discloses the claimed invention except for the active electrode array comprising at least four active electrodes. It would have been an obvious design choice to one with ordinary skill in the art at the time the invention was made to modify two active electrodes as taught by Neubauer et al. with four active electrodes, since applicant has not disclosed that this particular number of active electrodes provides any criticality and /or unexpected results and it appears that the invention would perform equally well with any number of active electrodes such as the two active electrodes taught by Neubauer et al. for stimulating the heart .

Response to Arguments

5. Applicant's arguments filed 2/6/04 have been fully considered but they are not persuasive.

6. Applicant's arguments with respect to claims 35-37 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

7. Claims 1-34 are allowed. See Paper No. 9, for reasons for indicating allowable subject matter.

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8. Claim 37 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. See Paper No. 9, for reasons for indicating allowable subject matter. Neubauer et al. does not show each active electrode in the electrode array comprises at least one lateral electrode contact and one medial electrode contact in combination with the tissue stimulation device comprising control, switching, and decoding circuitry as set forth in claim 35.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristen L Droesch whose telephone number is 703-605-1185. The examiner can normally be reached on M-F, 10:00 am - 6:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angie Sykes can be reached on 703-308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Krist Draerd

kld

Kennedy Schaeetzle
KENNEDY/SCHAEETZLE
PRIMARY EXAMINER
4-4-04